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Paper 111  
Entered: 29 January 2007

9 UNITED STATES PATENT AND TRADEMARK OFFICE  
10  
11

12 BEFORE THE BOARD OF PATENT APPEALS  
13 AND INTERFERENCES  
14

15  
16 JOSEPH A. ROSSIN and WILLIAM B. FEAVER,  
17

18 Junior Party  
19 Patent 6,673,326 B1,  
20

21 v.  
22

23 SHUICHI KANNO, TOSHIAKI ARATO, SHINZO IKEDA,  
24 KEN YASUDA, HISAO YAMASHITA, SHIGERU AZUHATA,  
25 SHIN TAMATA and KAZUYOSHI IRIE,  
26

27 Senior Party  
28 Application 10/676,013.  
29

30  
31 Patent Interference 105,402 McK  
32 Technology Center 1700  
33

34  
35 *Before: FRED E. McKELVEY, Senior Administrative Patent Judge, and*  
36 *RICHARD E. SCHAFER and ADRIENE LEPIANE HANLON,*  
37 *Administrative Patent Judges.*  
38

39 McKELVEY, *Senior Administrative Patent Judge.*  
40

41 MEMORANDUM OPINION and ORDER  
42 Decision on Kanno Motions 3, 4 and 5 and other issues

1  
2 This Memorandum Opinion and Order addressed Kanno Motion 3,  
3 Corrected Kanno Motion 4 and Corrected Kanno Motion 5.

4 Also addressed are (1) unpatentability of Rossin claims 10-15 for  
5 failure to comply with the fourth paragraph of 35 U.S.C. § 112 and (2) other  
6 issues.

7 In a separate opinion (Paper 114), we address the patentability of  
8 Rossin claims 1-3, 6-9 and 16-26. We held that Rossin claims 1-3, 6-9, and  
9 16-26 are unpatentable. Since Rossin claims 4-5 and 27 were designated as  
10 not corresponding to the sole count, they are not involved in the interference  
11 and therefore we have no occasion to address the patentability of those  
12 claims in this interference.

13  
14 **A. Findings of fact**

15 The following facts are believed to be supported by a preponderance  
16 of the evidence. To the extent that a finding in whole or in part is a  
17 conclusion of law, it may be treated as such.

18  
19 **(1) The junior party**

20 The junior party is:

21 Joseph A. Rossin and  
22 William B. Feaver.

23  
24 The junior party is involved on the basis of:

25 U.S. Patent 6,673,326 B1  
26 granted 06 January 2004  
27 based on application 09/633,609  
28 filed 07 August 2000.

29  
30 The real party in interest is Guild Associates, Inc.

1                                   **(2) The senior party**

2           The senior party is

3                                   Shuichi Kanno,  
4                                   Toshiaki Arato,  
5                                   Shinzo Ikeda,  
6                                   Ken Yasuda,<sup>1</sup>  
7                                   Hisao Yamashita,  
8                                   Shigeru Azuhata,  
9                                   Shin Tamata and  
10                                  Kazuyoshi Irie.

11  
12          The senior party is involved on the basis of:

13                                   application 10/676,013,  
14                                   filed 02 October 2003.

15  
16          The real party in interest is Hitachi, Ltd.

17          The senior party has been accorded a constructive reduction to  
18 practice, *i.e.*, benefit for the purpose of priority, of:

19                                   application 09/005,006,  
20                                   filed 09 January 1998.

21  
22                                   **(3) The count**

23          Count 1 is the only count (Paper 1, page 7):

24  
25                                   Count 1

26                                  A process for reducing the concentration of a sample  
27                                  comprising perfluorinated compounds,  
28                                  said process comprising contacting the sample with a  
29                                  catalyst under conditions such that the concentration of  
30                                  perfluorinated compounds in the sample is reduced,

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<sup>1</sup> Ken Yasuda is also known as Takeshi Yasuda.

1                   said catalyst consisting of (1) aluminum oxide ( $\text{Al}_2\text{O}_3$ )  
2                   and (2) an enhancer selected from the group consisting of nickel  
3                   and cobalt.

4  
5                   **(4) Kanno Motion 3**

6                   Kanno Motion 3 (Paper 42) seeks to substitute proposed Count A for  
7   Count 1.

8                   In addition, as to proposed Count A, Kanno seeks to be accorded a  
9   constructive reduction to practice based on Japanese application 09-004349  
10   (14 January 1997) and Japanese application 09-163717 (20 June 1997).

11                  Rossin Opposition 3 (Paper 62) was timely filed.

12                  Assuming that Count A is substituted for Count 1, Rossin seeks to be  
13   accorded a constructive reduction to practice based on application  
14   09/633,609 (7 August 2000), now U.S. Patent 6,673,326 (06 January  
15   2004)—which is the Rossin patent involved in the interference.

16                  Kanno Reply 3 (Paper 82) was timely filed.

17                  According to Kanno, Count 1 covers multiple patentably distinct  
18   inventions (Paper 42, page 2).

19                  Proposed Count A—sought to be substituted for Count 1:

20  
21                                 Proposed Count A

22                   A process for reducing the concentration of a sample  
23                   comprising a compound consisting of nitrogen and fluorine,  
24                   said process comprising contacting the sample with a  
25                   catalyst under conditions such that the concentration of  
26                   compound in the sample is reduced,

1                   said catalyst consisting of (1) aluminum oxide ( $\text{Al}_2\text{O}_3$ )  
2                   and (2) nickel.

3  
4                   Proposed Count A compared to Count 1

5                   A process for reducing the concentration of a sample  
6                   comprising ~~perfluorinated compounds~~ **a compound consisting**  
7                   **of nitrogen and fluorine,**

8                   said process comprising contacting the sample with a  
9                   catalyst under conditions such that the concentration of  
10                  ~~perfluorinated compounds~~ **the compound** in the sample is  
11                  reduced,

12                  said catalyst consisting of (1) aluminum oxide ( $\text{Al}_2\text{O}_3$ )  
13                  and (2) ~~an enhancer selected from the group consisting of nickel~~  
14                  ~~and cobalt.~~

15  
16                   **(5) Kanno Corrected Motion 4**

17                  Kanno Corrected Motion 4 (Paper 76)<sup>2</sup> seeks to add proposed  
18                  Count B.

19                  Kanno also moves to add a Claim 39 to its involved application.  
20

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<sup>2</sup> Kanno Corrected Motion 4 (Paper 76) replaces Kanno Motion 4 (Paper 37).

1 Claim 39

2 A method for reducing a concentration of a sample  
3 comprising a compound consisting of nitrogen and fluorine,  
4 the method comprising contacting the sample with a  
5 catalyst under conditions such that the concentration of the  
6 sample [sic—compound] is reduced,  
7 the catalyst comprising zirconia and nickel oxide.

8  
9 As to Count B, Kanno also seeks to be accorded a constructive  
10 reduction to practice based on Japanese application 09-004349 (14 January  
11 1997) and Japanese application 09-163717 (20 June 1997).

12 Rossin Opposition 4 (Paper 63) was timely filed.

13 Kanno Reply 4 (Paper 83) was timely filed.

14  
15 Proposed Count B

16 A method for reducing the concentration of a sample  
17 comprising a compound consisting of nitrogen and fluorine,  
18 the method comprising contacting the sample with a  
19 catalyst under conditions such that the concentration of the  
20 sample [sic—compound] is reduced,  
21 said catalyst comprising zirconia and nickel oxide.

22  
23 **(6) Kanno Corrected Motion 5**

24 Kanno Corrected Motion 5 (Paper 77)<sup>3</sup> seeks to add proposed Count

25 C.

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<sup>3</sup> Kanno Corrected Motion 5 (Paper 77) replaces Kanno Motion 5 (Paper 36).

1 Kanno also moves to add a Claim 40 to its involved application.

2  
3 Claim 40

4 A method for reducing a concentration of a sample  
5 comprising a compound consisting of nitrogen and fluorine,  
6 the method comprising contacting the sample with a  
7 catalyst under conditions such that the concentration of the  
8 sample [sic—compound] is reduced,  
9 said catalyst comprising a mixture of alumina, and  
10 (1) 0.1-20% by weight of sulfur on the basis of the catalyst, or  
11 (2) up to 10% by weight of sulfate on the basis of the catalyst.

12  
13 As to Count C, Kanno also seeks to be accorded a constructive  
14 reduction to practice based on Japanese application 09-004349 (14 January  
15 1997) and Japanese application 09-163717 (20 June 1997).

16 Rossin Opposition 5 (Paper 64) was timely filed.

17 Kanno Reply 5 (Paper 84) was timely filed.

18  
19 Proposed Count C

20 A method for reducing the concentration of a sample  
21 comprising a compound consisting of nitrogen and fluorine,  
22 the method comprising contacting the sample with a  
23 catalyst under conditions such that the concentration of the  
24 sample [sic—compound] is reduced,  
25 said catalyst comprising a mixture of alumina, and  
26 (1) 0.1-20% by weight of sulfur on the basis of the catalyst, or  
27 (2) up to 10% by weight of sulfate on the basis of the catalyst.

1                                   **(7) Comparison of Count 1 and proposed counts**

2	Count	Compound	Catalyst
3		in sample	mixture
4			
5	1	Perfluorinated compounds	(1) alumina and (2) nickel or cobalt
6	A	Nitrogen and fluorine	(1) alumina and (2) nickel
7	B	Nitrogen and fluorine	(1) zirconia and (2) nickel oxide
8	C	Nitrogen and fluorine	(1) alumina and (2) sulfur compound
9			

10                                   **(8) Examiner's restriction requirement**

11           The involved Kanno application is a continuing application from  
12 earlier filed Kanno "parent" application 09/005,006 (09 January 1998).

13           As filed, the Kanno parent application contained claims 1-21.  
14 Ex 1011.

15           During prosecution of the Kanno parent application, the examiner  
16 entered a restriction requirement. Ex 1011.

17           According to the examiner, claims 1, 16 and 20 were generic (i.e.,  
18 covered) a plurality of patentably distinct species. Ex 1011, page 2.

19           The patentably distinct perfluorinated compounds to be treated species  
20 were determined to be those having the following elements:

21                   (1) carbon and fluorine, e.g., CF<sub>4</sub>.

22                   (2) carbon, hydrogen and fluorine, e.g., CHF<sub>3</sub>.

23                   (3) sulfur and fluorine, e.g., SF<sub>6</sub>.

24                   (4) nitrogen and fluorine, e.g., NF<sub>3</sub>.

25                   (5) carbon, hydrogen, oxygen and fluorine, e.g., CH<sub>2</sub>OCF<sub>2</sub>.

26



1 The patentably distinct catalysts were determined to be the following:

2 (a) alumina.

3 (b) titania.

4 (c) zirconia.

5 (d) silica.

6 (e) mixtures of any of (a) through (d).

7 (f) mixtures of alumina and another compound, *e.g.*, nickel.

8 (g) mixtures of titania and another compound, *e.g.*, nickel.

9 (h) mixtures of zirconia and another compound, *e.g.*, nickel.

10 (i) mixtures of silica and another compound, *e.g.*, nickel.

11 (j) mixture of any of (a) through (d) with another compound.

12  
13 Rossin apparently disagrees with the examiner's restriction  
14 requirement. Paper 62, page 4.

15 According to Rossin, perfluoroalkanes are "stable" compounds and in  
16 fact are said to be more stable than N-F compounds. *Id.*

17 Rossin reasons that if a method can be used for reducing  
18 perfluoroalkanes in a sample, then use of the same method for reducing N-F  
19 compounds would have been obvious. *Id.*

20 Rossin also argues that Kanno cannot rely on the examiner's  
21 restriction requirement because Kanno did not "traverse" the restriction  
22 requirement. *Id.* at 8, lines 17-18.

23  
24 **(9) Claims 10-15**

25 At the time the interference was declared, the Board noted certain  
26 35 U.S.C. § 112, fourth paragraph, problems with respect to Rossin

claims 11-15 (Paper 3). Rossin claim 10 also suffers from a failure to comply with § 112, fourth paragraph.

Rossin claim 1 reads as follows (*italics added*):

Rossin claim 1

A process for reducing the concentration of perfluorinated compounds or hydrofluorocarbon compounds in a sample, the process *comprising*:  
contacting said sample with a catalyst to produce a reacted sample, wherein the catalyst *consists of*  $\text{Al}_2\text{O}_3$ , and one or more enhancers selected from the group consisting of nickel, cobalt, and sulfate.

Rossin claims 10-15 depend directly or indirectly from Rossin claim 1.

Rossin claim 10

The process of claim 1, wherein the catalyst further comprises  $\text{ZrO}_2$ .

Rossin claim 11

The process of claim 1, wherein the catalyst further comprises an oxidation catalyst.

Rossin claim 12

The process of claim 11, wherein the concentration of oxidation catalyst in the catalyst is greater [than] 0 weight percent and less than about 10 weight percent.

1                                   Rossin claim 13

2                                   The process of claim 11, wherein the oxidation catalyst is  
3                                   platinum.

4  
5                                   Rossin claim 14

6                                   The process of claim 11, wherein the oxidation catalyst is  
7                                   selected from the group consisting of palladium, rhodium, and  
8                                   iridium.

9  
10                                  Rossin claim 15

11                                 The process of claim 11, wherein the oxidation catalyst is  
12                                 selected from the group consisting of silver, nickel, copper,  
13                                 iron, vanadium, and cerium.

14  
15                                 Other findings as necessary appear in the Discussion portion of this  
16                                 opinion.

17  
18                                   **B. Discussion**

19                                 **(1) Unpatentability of Rossin claims 10-15**

20                                 Rossin claims 10-15 are unpatentable under the fourth paragraph of  
21                                 35 U.S.C. § 112, which reads in pertinent part:

22  
23                                 [A] claim in dependent form shall contain a reference to a claim  
24                                 previously set forth and then specify a further limitation of the  
25                                 subject matter claimed. A claim in dependent form shall be  
26                                 construed to incorporate by reference all of the limitations of  
27                                 the claim to which it refers.

28  
29                                 Rossin claim 1 calls for the use of a catalyst.

1           The catalyst "consists of  $\text{Al}_2\text{O}_3$ , and one or more enhancers selected  
2   from the group consisting of nickel, cobalt, and sulfate."

3           The language "consists of" is a term of art in patent law. Since  
4   *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948), the Patent and  
5   Trademark Office has interpreted the phrase "consisting of" in a claim to  
6   limit the claim to the materials recited and impurities ordinarily associated  
7   with those materials. The former Court of Customs and Patent Appeals and  
8   the Court of Appeals for the Federal Circuit have consistently followed  
9   *Davis*. At this point, it would be fair to say that the phrases "consisting of",  
10   "consists of", "consisting essentially of" and "comprising" have well-  
11   established meanings. *See, e.g., In re Janakirama-Rao*, 317 F.2d 951, 954,  
12   137 USPQ 893, 896 (CCPA 1963) ("consisting essentially of"); *In re*  
13   *DeLajarte*, 337 F.2d 870, 873, 143 USPQ 256, 258 (CCPA 1964)  
14   ("consisting essentially of"); *In re Herz*, 537 F.2d 549, 551, 190 USPQ 461,  
15   463 (CCPA 1976) ("consisting essentially of"); *In re Baxter*, 656 F.2d 679,  
16   686, 210 USPQ 795, 802 (CCPA 1981) ("comprising"); *Moleculon Research*  
17   *Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271, 229 USPQ 805, 812 (Fed. Cir.  
18   1986) ("comprising"); *PPG Industries, Inc. v. Guardian Industries Corp.*,  
19   156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998)  
20   ("consisting essentially of" occupies middle ground between "consisting of"  
21   and "comprising"); *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195  
22   F.3d 1322, 1329, 52 USP2d 1590, 1596 (Fed. Cir. 1999) ("comprising" and  
23   "consisting of"); *The Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d  
24   1367, 1372, 74 USPQ 1586, 1590 (Fed. Cir. 2005) ("consisting of" in  
25   Markush group closes group to listed items); *CollegeNet, Inc. v.*  
26   *ApplyYourself, Inc.*, 418 F.3d 1225, 1235, 75 USPQ2d 1733, 1741 (Fed. Cir.

1 2005) ("comprising"); *In re Fisher*, 421 F.3d 1365, 1368, 76 USPQ2d 1225,  
2 1227 (Fed. Cir. 2005) ("consisting of").

3       There is also precedent dealing with claims which have both  
4 (1) "comprising" and (2) "consists of" or "consisting of". *See, e.g., In re*  
5 *Crish*, 393 F.3d 1253, 1257, 73 USPQ2d 1364, 1367 (Fed. Cir. 2004) (in a  
6 claim reading "A purified oligonucleotide comprising at least a portion of  
7 the \*\*\* sequence \*\*\* wherein the portion consists of \*\*\*" only the "portion"  
8 was limited to "consists" not the entire oligonucleotide); (2) *Mannesmann*  
9 *Demag Corp. v. Engineered Metal Products Co., Inc.*, 793 F.2d 1279, 1282,  
10 230 USPQ 45, 46 (CCPA 1986) (in a claim comprising elements (a), (b), (c)  
11 and (d), where element (a) "consisting of", only element (a) was limited to  
12 what was recited after "consists of"); *Berenter v. Quigg*, 737 F.Supp. 5, 7, 14  
13 USPQ2d 1175, 1176 (D.D.C. 1988) (in a method claim with comprising in a  
14 preamble and consisting of in one step, the step was limited because of  
15 "consisting of").

16       A review of Rossin claim 10 reveals that it falls into the Crish-  
17 Mannesmann-Berenter type of claim. The "process" "*comprises*" a step of  
18 contacting a sample with a catalyst which "*consists of*" Al<sub>2</sub>O<sub>3</sub> (alumina) and  
19 at least one enhancer selected from the group "*consisting of*" nickel, cobalt,  
20 and sulfate. While the process can involve steps other than the catalyst-  
21 contacting step recited in the claim, the catalyst "consists of" only the  
22 catalyst recited, *e.g.*, a mixture of (1) alumina and (2) one or more of nickel,  
23 cobalt, and sulfate.

24       Rossin claim 10 covers the use of a catalyst which has ZrO<sub>2</sub>  
25 (zirconia). Rossin claim 1 excludes the presence of zirconia. The subject  
26 matter of the claims is non-overlapping. *Cf. Pfizer, Inc. v. Ranbaxy*  
27 *Laboratories Limited*, 457 F.3d 1284, 79 USPQ2d 1583 (Fed. Cir. 2006)

1 (claim 1 covered a member selected from atorvastatin acid or atorvastatin  
2 lactone or pharmaceutically acceptable salts thereof; dependent claim 2  
3 limited the member to atorvastatin acid; claim 6, dependent from claim 2,  
4 sought to cover the hemicalcium salt of the compound of claim 2; court  
5 found claim 2 and claim 6 to cover non-overlapping subject matter because  
6 dependent claim 2 did not cover a salt). Rossin claim 10 is therefore  
7 unpatentable under the fourth paragraph of 35 U.S.C. § 112. Rossin claims  
8 11-15 are also unpatentable for essentially the same reason.

9 At oral argument it was suggested that consideration of the  
10 patentability of Rossin claims 10-15 for improper dependency should be  
11 taken up at some future date in the interference. The fact is the claims are  
12 unpatentable under 35 U.S.C. § 112, fourth paragraph. The only vehicle for  
13 somehow correcting the claims would be through filing a reissue application.  
14 Whether a reissue will be successful is not a matter we decide today.  
15 Rather, we enter an order holding Rossin claims 10-15 unpatentable. Our  
16 order is entered without prejudice to Rossin filing a reissue application  
17 wherein an attempt may be made to correct the error. Whether (1) any  
18 proposed new reissue claim would be patentable over the prior art, (2) any  
19 recapture rejection would be appropriate (based on any amendments which  
20 may have been made to secure allowance of claims) and (3) any interference  
21 estoppels might apply, are matters we leave to the examiner to determine in  
22 the first instance. If a reissue is filed and if claims are rejected and if Rossin  
23 takes an appeal to this Board, then Rossin should (1) identify this  
24 interference as a related case and (2) in the related cases statement indicate  
25 that the interference was decided by Judges McKelvey, Schafer and Hanlon.

26  
27

1                                   **(2) Kanno Motion 3**

2           Rossin claims 1-3, 6-9 and 16-26 have been held to be unpatentable  
3 over the prior art. Rossin claims 4, 5 and 27 are not involved in the  
4 interference.

5           At the time the interference was declared, the examiner's restriction  
6 requirement had been overlooked by the Board. Had the Board been aware  
7 of the restriction requirement, the interference would have been declared  
8 with a count similar to proposed Count A and not Count 1.

9           Upon a review of the restriction requirement, it is now the opinion of  
10 the Board that proposed Count A is a more appropriate count. Hence, at this  
11 point a count like proposed Count A would have been substituted for  
12 Count 1 even if Kanno had not filed Kanno Motion 3.

13           Without deciding whether a sua sponte decision by the Board obviates  
14 Kanno's burden of proof to obtain relief on the basis of Kanno Motion 3, we  
15 think Kanno has satisfied its burden of proof under the particular facts of this  
16 case.

17           The examiner made a restriction requirement. A decision by an  
18 examiner to restrict should be presumed to be correct. In this respect, we  
19 note that the rules authorize an applicant to request reconsideration of a  
20 restriction requirement. 37 CFR § 1.143 (2006). The rules also authorize an  
21 applicant to file a petition to seek administrative review of a final decision of  
22 an examiner maintaining a restriction requirement. 37 CFR § 1.144 (2006).  
23 Accordingly, to the extent Rossin urges that Kanno was under a burden to  
24 show that the examiner's restriction requirement was correct, we decline to  
25 announce a "rule" that a party relying on a restriction requirement must  
26 independently establish that the restriction requirement was correct. It  
27 follows that a failure on the part of Kanno to "traverse" the restriction

1 requirement is not prejudicial to the position being taken by Kanno in this  
2 interference.

3 A count in an interference should cover a single patentable invention.  
4 See, e.g., 37 CFR § 41.201 (2006) (definition of count: "where there is more  
5 than one count, each count must describe a patentably distinct invention.").

6 Why? The answer is manifest from a PTO decision quoted at length in  
7 *Godtfredsen v. Banner*, 598 F.2d 589, 592, 202 USPQ 7, 10 (CCPA 1979):

8 Where, as here, the parties both disclose the same three species,  
9 that fact does not justify including those species in a single  
10 count as members of a Markush group if the Examiner has  
11 determined that the three species are patentably distinct  
12 inventions. If such a count were permitted, then the party who  
13 proved the earliest date of invention as to any one of the  
14 members of the group would be awarded priority as to the  
15 entire count, i.e., as to all three members. It is not considered  
16 that such a result would be consonant with the primary purpose  
17 of an interference or with the intent of 35 U.S.C. 135, since  
18 there would be no determination of priority as to *each* of the  
19 common [patentably distinct] inventions claimed by the parties.  
20 (emphasis in original; matter in brackets added.)

21  
22 The gist of Kanno's argument is that if a person having ordinary skill  
23 in the art would have been aware of a process for reducing perfluoroalkanes  
24 in a sample using a particular method, there is no credible evidence that one  
25 skilled in the art would have also found that method useful for reducing N-F  
26 compounds in a similar sample. Apparently, the examiner in entering the  
27 restriction requirement agreed. It goes without saying that evidence is



1 needed to establish obviousness. Kanno says there is no evidence. A lack of  
2 evidence and a determination by the examiner that subject matter is  
3 patentably distinct is sufficient to satisfy Kanno's burden of proof.

4       What about Rossin's rebuttal? Rossin, relying on prior art which  
5 Rossin says the examiner did not consider (or perhaps did not know existed)  
6 establishes the "obviousness" of substituting an N-F compound for the  
7 perfluoroalkane in the method for reducing perfluoroalkanes in a sample.

8 Rossin takes us through a rather elaborate analysis involving bond strengths  
9 in an attempt to make out a rebuttal case. We are not impressed, and decline  
10 to credit, Rossin's argument and the evidence relied upon in support of that  
11 argument, to the extent that it attempts to make out a case of obviousness of  
12 the reducing N-F compounds based on a presumed prior art use of a process  
13 to reduce perfluoroalkanes. We fail to grasp why the bond strength  
14 differences would have made obvious the substitution of one compound with  
15 one bond strength (N-F) for another compound with a different bond  
16 strength (perfluoroalkanes). One concern not convincingly addressed by  
17 Rossin is the general unpredictability of catalytic activity. *Cf. Corona Cord*  
18 *Tire Co. v. Dovan Chemical Corp.*, 276 U.S. 358, 385 (1928) (see discussion  
19 with respect to claims 1, 5, and 9); *Windemuth v. Brenner*, 265 F.Supp. 487,  
20 153 USPQ 112 (D.D.C. 1967). Although Rossin had an opportunity to do  
21 so, Rossin did not present evidence on the predictability of catalytic activity  
22 for the various catalysts described by both Rossin and Kanno.

23       Under the facts of this case, if Rossin were to prove priority of a  
24 method based on a perfluoroalkane, we do not think that proof would render  
25 obvious under 35 U.S.C. § 103 the use of a method based on N-F  
26 compounds. Accordingly, Kanno's request to "narrow" the interfering  
27 subject matter to N-F compounds is proper.

1           Kanno Motion 3 will be granted to the extent that proposed Count A  
2 (Count 2) will be substituted for Count 1 and the interference will be  
3 redeclared in a separate paper.

4           In Kanno Motion 3, Kanno seeks benefit for the purpose of priority, as  
5 to proposed Count A, of earlier filed Kanno applications: Japanese  
6 application 09-004349 (14 January 1997) and Japanese application  
7 09-163717 (20 June 1997). Each application describes an enabled  
8 embodiment within the scope of proposed Count A. According, the  
9 requested benefit is granted.<sup>4</sup>

10           In opposing Kanno Motion 3, Rossin also seeks benefit for the  
11 purpose of priority of the involved Rossin patent. The involved application  
12 is entitled to its filing date and there is no need for a request by Rossin for  
13 "benefit" as to its involved application.

14  
15

---

<sup>4</sup> In opposing Kanno Motion 3, Rossin attempts to rely on Rossin Opposition 1 to Kanno Motion 1: "For the reasons provided in Rossin Opposition 1, the Kanno '013 application is not entitled to priority under 35 U.S.C. § 119." A party is not authorized to incorporate in a "second" opposition arguments made in a first "opposition." STANDING ORDER, ¶ 106.2 (3 Jan. 2006). In deciding Kanno Motion 3, we have not considered any argument made in Rossin Opposition 1.

1           **(3) Kanno Corrected Motion 4 and Kanno Corrected Motion 5**

2           Kanno Corrected Motion 4 seeks to add proposed Kanno claim 39 to  
3 the involved Kanno application and to add proposed Count B to the  
4 interference, with proposed Kanno claim 39 being designated as  
5 corresponding to proposed Count B.

6           In opposing Kanno Corrected Motion 4, Rossin argues that proposed  
7 Kanno claim 39 is unpatentable under (1) 35 U.S.C. § 135(b) (not timely  
8 presented) and (2) 35 U.S.C. § 102/103 (over the prior art).

9           Kanno Corrected Motion 5 seeks to add proposed Kanno claim 40 to  
10 the involved Kanno application and to add proposed Count C to the  
11 interference, with proposed Kanno claim 40 being designated as  
12 corresponding to proposed Count C.

13           In opposing Kanno Corrected Motion 5, Rossin argues that proposed  
14 Kanno claim 40 is unpatentable under 35 U.S.C. § 135(b) (not timely  
15 presented).

16           Proposed Kanno claims 39 and 40 have not been examined by an  
17 examiner.

18           Under the circumstances of this case, we believe that an appropriate  
19 course of action is to dismiss Kanno Corrected Motion 4 and Kanno  
20 Corrected Motion 5, without prejudice to Kanno presenting proposed Kanno  
21 claims 39 and 40 for *ex parte* examination (in view of the restriction  
22 requirement mentioned earlier, the examiner may insist that the claims be  
23 presented in a different application). If the examiner determines that (1)  
24 either or both of proposed Kanno claims 39 and 40 are patentable and (2)  
25 there is an interference-in-fact between Rossin claim 5 and Kanno claim 39  
26 and/or Rossin claim 27 and Kanno claim 40, the examiner is free to  
27 recommend to the Board that additional interferences be declared.

1                                   **(4) Interference 105,512**

2           Simultaneously with entry of this MEMORANDUM OPINION and  
3 ORDER, Interference 105,512 is being declared between Rossin and Kanno  
4 with a count covering the subject matter of claim 4 of the Rossin patent  
5 involved in this interference and claims 1-15 of Kanno application  
6 11/294,376 (the application is not involved in this interference). Rossin  
7 claim 4 covers a method of reducing the concentration of trifluoromethane  
8 and tetrafluoroethane, both of which are perfluoroalkanes.

9  
10           **C. Order**

11           Upon consideration of the record, and for the reasons given herein as  
12 well as in the MEMORANDUM OPINION (Paper 114) addressing the  
13 patentability of Rossin claims 1-3, 6-9 and 16-26, it is

14                       ORDERED that Kanno Motion 2 is granted.

15           FURTHER ORDERED that Rossin claims 1-3, 6-9, and 16-26 are  
16 unpatentable over the prior art. 35 U.S.C. §§ 102/103.

17           FURTHER ORDERED that Rossin is not entitled to a patent  
18 containing Rossin claims 1-3, 6-9 and 16-26. 35 U.S.C. §§ 102/103.

19           FURTHER ORDERED that Rossin claims 10-15 are  
20 unpatentable for failure to comply with the fourth paragraph of 35 U.S.C.  
21 § 112.

22           FURTHER ORDERED that Rossin is not entitled to a patent  
23 containing Rossin claims 10-15. 35 U.S.C. § 112, fourth paragraph; *Pfizer,*  
24 *Inc. v. Ranbaxy Laboratories Limited*, 457 F.3d 1284, 79 USPQ2d 1583  
25 (Fed. Cir. 2006).

26           FURTHER ORDERED that Kanno Motion 3 is granted.

1           FURTHER ORDERED that Kanno proposed Count A (now  
2 Count 2) is substituted for Count 1.

3           FURTHER ORDERED that Kanno Corrected Motion 4 and  
4 Kanno Corrected Motion 5 are dismissed without prejudice Kanno  
5 presenting proposed Kanno claims 39 and 40 for consideration by the  
6 examiner.

7           FURTHER ORDERED that it is not necessary to decide any  
8 motion seeking to be accorded an earlier constructive reduction to practice  
9 and therefore those motions are dismissed as moot.

10          FURTHER ORDERED that a copy of this MEMORANDUM  
11 OPINION and ORDER (Paper 111) and a copy of the MEMORANDUM  
12 OPINION (Paper 114) shall be placed in the files of (1) Kanno application  
13 10/676,013 and (2) Rossin U.S. Patent 6,673,326 B1.

14          FURTHER ORDERED that if there is a settlement, attention is  
15 directed to 35 U.S.C. § 135(c).

16

17

18           /ss/ Fred E. McKelvey )

19           FRED E. McKELVEY )

20           *Senior Administrative Patent Judge* )

21           ) BOARD OF

22           /ss/ Richard E. Schafer ) PATENT

23           RICHARD E. SCHAFER ) APPEALS

24           *Administrative Patent Judge* ) AND

25           ) INTERFERENCES

26           /ss/ Adriene Lepiane Hanlon )

27           ADRIENE LEPIANE HANLON )

28           *Administrative Patent Judge* )

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